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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/817,599	04/02/2004	Michael Joseph Toutonghi	13768.991	3131
47973 7590 03/17/2009 WORKMAN NYDEGGER/MICROSOFT 1000 EAGLE GATE TOWER 60 EAST SOUTH TEMPLE SALT LAKE CITY, UT 84111				
EXAMINER				
WILLIAMS, CLAYTON R				
ART UNIT		PAPER NUMBER		
2457				
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03/17/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/817,599

Applicant(s)

TOUTONGHI, MICHAEL JOSEPH

Examiner

Clayton R. Williams

Art Unit

2457

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 March 2009.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1.5-7.9-14, 18, 22, 24 and 25 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1.5-7.9-14, 18, 22, 24 and 25 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/888)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

1. Claims 1, 5-7, 9-14, 18 and 22-25 are pending in this application per amendment.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 01/14/2009 has been entered.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim(s) 1, 5-7, 9-14, 18 and 22-25 are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. While the claims recite a series of steps or acts to be performed, a statutory "process" under 35 U.S.C. 101 must (1) be tied to particular machine, or (2) transform underlying subject matter (such as an article or material) to a different state or thing. See page 10 of In Re Bilski 88 USPQ2d 1385. The instant claims are neither positively tied to a particular machine that accomplishes

the claimed method steps nor transform underlying subject matter, and therefore do not qualify as a statutory process. The methods described are broad enough that the claims could be completely performed mentally, verbally or without a machine nor is any transformation apparent. Additionally, para. [0033] of the instant application defines computer-readable media as including electromagnetic signals.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 9-11, 13, 14, 18 and 22-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mohsenin al. (20050075895: hereinafter Mohsenin), in view of Bucher (6928476: hereinafter Bucher).

For claims 1, 14 and 18, Mohsenin discloses a method for a data acquisition device, which is configured to generate at least two different types of data objects, to distinguish between the at least two different types of data objects, and to selectively and automatically transfer only some of the data objects, including a new data object to a user storage device and based upon a determination of data object type, the method comprising:

detecting that a new data object has been created and stored on the data acquisition device ([0024]);

determining a type of the new data object from a plurality of available types, wherein the plurality of available types comprise a sound data object type, a voice data object type, an image data object type, and a video data object type ([0021]);

accessing a configuration file which specifies which type of data objects are to be stored locally and which type of data objects are to be stored remotely, and determining that the configuration file specifies that the new data object is of a particular type that should be stored remotely at a user storage device ([0027]);

establishing a communication session with the selected user storage device using the network address corresponding to the selected user storage device ([0021]);
and

sending the new data object to the selected user storage device for storage therein ([0021]).

Mohsenin fails to explicitly disclose:

establishing a communication session with an online connection service and communicating with the online connection service to obtain a list of available user storage devices associated with the data acquisition device wherein the list includes a network address for each available user storage device on the list;

selecting, from the list, an available user storage device on which to store the new data object);

However, Bucher discloses a remote data storage system that presents a user device with a list of remote storage devices to which data may be sent (Bucher, col. 7, lines 1-10). Mohsenin and Bucher are analogous art because both are from the field of the transfer of data from a client to a remote server.

It would have been obvious to one skilled in the art at the time of the invention to modify the teachings of Mohsenin with those of Bucher, because this modification would extend the remote storage system to allow for a plurality of remote storage options.

For claim 9, the combination of Mohsenin and Bucher discloses the method of claim 1, wherein communicating with the online connection service comprises sending authentication information to authenticate the data acquisition device to the online connection service (Mohsenin, [0024], lines 16-25).

For claim 10, the combination of Mohsenin and Bucher discloses the method of claim 1, further comprising requesting permission to store the new data object at the at least one available user storage device before sending the object to the at least one available user storage device (Bucher, col. 4, lines 23-29, disclosure that remote storage device must first approve data transfer before receipt of data).

For claim 11, the combination of Mohsenin and Bucher discloses the method of claim 10, wherein the requesting permission is performed implicitly by sending authentication

information to the at least one available user storage device and receiving an authentication success message from the at least one available user storage device (Bucher, col. 4, lines 23-29, disclosure that remote storage device must first approve data transfer before receipt of data).

For claim 13, the combination of Mohsenin and Bucher discloses the method of claim 1, wherein establishing the communication session with the at least one available user storage device comprises establishing a link with the at least one available user storage device through an intermediate proxy server (Bucher, col. 4, lines 43-48).

For claim 22, the combination of Mohsenin and Bucher discloses the method of claim 21, further comprising wherein the configuration file included on the data acquisition device is input by a user (Mohsenin, [0027]).

For claim 23, the combination of Mohsenin and Bucher discloses the method of claim 1, wherein the online connection service stores active presence information about the available user storage devices associated with the data acquisition device (Bucher, col. 7, lines 1-4, disclosure that system only provides information regarding "available" systems).

For claim 24, the combination of Mohsenin and Bucher discloses the method of claim 1, wherein establishing a communications session with the at least one available user

storage device comprises a communications session which is separate and distinct from the communications session with the online connection service (Bucher, col. 7, lines 38-43).

For claim 25, the combination of Mohsenin and Bucher discloses the method of claim 1, wherein image data objects are of the particular type configured for automatic transfer, while voice data objects are not, and such that, such that image data objects are selected for automatic transfer while voice data objects are refrained from being selected for automatic transfer (Mohsenin, [0027]).

6. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mohsenin, in view of Bucher, and further in view of Snyder et al. (5564109: hereinafter Snyder).

For claim 5, the combination of Mohsenin and Bucher fails to explicitly disclose the method of claim 1, further comprising receiving a prioritized list of available user storage devices associated with the data acquisition device from the online connection service.

However, Snyder discloses a system which provides a user with a ranked list of peripherals which can perform a designated task. (Synder, col. 4, lines 5-10). The combination and Synder are analogous art because both solve the problem of matching

a user device with an appropriate remote device by way of providing a list of suitable devices to a requesting user device.

It would have been obvious to one skilled in the art at the time of the invention to modify the teachings of the combination with those of Synder, because this modification would extend the remote storage system as taught by the combination to include providing a requesting user device with a ranked list of available entities on which to store data.

7. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mohsenin, in view of Bucher, and further in view of Harrow et al., US 20030009586 (hereinafter Harrow).

For claim 12, the combination of Mohsenin and Bucher fails to explicitly disclose wherein establishing the communication session with the at least one available user storage device comprises establishing a peer- to-peer link with the at least one available user storage device.

However, Harrow discloses a system which directs a client to establish a peer-to-peer connection to another peer for the purpose of carrying out a desired function (Harrow, [0027]). The combination and Harrow are analogous art because both are from the field of matching a user device with an appropriate remote device to carry out a desired function.

It would have been obvious to one skilled in the art at the time of the invention to modify the teachings of the combination with those of Harrow, because this modification would extend the remote storage system as taught by the combination to include peer-to-peer style data connections.

7. Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mohsenin, in view of Bucher, in view of Snyder, and further in view of Domenikos et al. (5838916: hereinafter Domenikos).

For claim 6, the combination of Mohsenin, Bucher and Snyder fails to explicitly disclose further comprising receiving information on the communications protocols supported by each available user storage device on the prioritized list.

However, Domenikos discloses a system which provides a client system with a list of servers, including communication protocol information, that provide a desired service (Domenikos, col. 19, lines 18-35). The combination and Domenikos are analogous art because both solve the problem of providing a user device with an appropriate remote device by way of providing a list of suitable devices to a requesting user device.

It would have been obvious to one skilled in the art at the time of the invention to modify the teachings of the combination with those of Domenikos, because this modification would extend the combination to include providing a requesting user device

with a ranked list, which includes protocol information, of available entities on which to store data.

For claim 7, the combination of Mohsenin, Bucher, Snyder and Domenikos discloses the method of claim 6, wherein the sending of the new data object is in accordance with the communications protocol supported by the at least one available user storage device (Domenikos, col. 19, lines 18-35, it is inherent that user device will make use of information collected regarding methods for interfacing with remote devices with regard to establishing connection).

Response to Arguments

Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

Applicant argues prior art of record does not teach accessing a configuration file to determine whether the data object is of a type which is to be remotely stored. Examiner respectfully disagrees. Mohsenin in combination teaches such a feature, see Mohsenin, ([0027]).

Applicant argues prior art of record does not teach determining a type of the new data object from a plurality of available types. Examiner respectfully disagrees. Mohsenin in combination teaches a mobile phone equipped with a camera, see Mohsenin, ([0021]). As such, this apparatus possesses capabilities to acquire both audio and image/video based content.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clayton R. Williams whose telephone number is 571-270-3801. The examiner can normally be reached on M-F (8 a.m. - 5 p.m.).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on 571-272-4001. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Mar. 12, 2009
CRW

Clayton R. Williams
Patent Examiner
Art Unit 2457

/ARIO ETIENNE/

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Supervisory Patent Examiner, Art Unit 2457